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FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER LLP 901 NEW YORK AVENUE, NW WASHINGTON, DC 20001-4413				
EXAMINER				
VENKAT, JYOTHSNA A				
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1619				
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/654,907

**Applicant(s)**

DE LA POTERIE ET AL.

**Examiner**

JYOTHSNA A. VENKAT

**Art Unit**

1619

**Period for Reply** -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 26 January 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-24 and 79-107 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-24 and 79-107 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/S508)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

**DETAILED ACTION**

Receipt is acknowledged of remarks filed on 1/26/09.

**Status of claims**

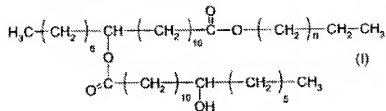
Claims 25-78 and 108-117 are withdrawn from consideration as being drawn to non-elected subject matter (election with traverse dated 1/11/07). Claims 1-24 and 79-107 are currently examined in the application.

***Claim Rejections - 35 USC § 112***

Claims 1-10, 12-24 and 79-107 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. **This is written description rejection.**

The specification discloses a tack of greater than or equal to 0.7 N.s and a hardness of less than or equal to 3.5 MPa drawn to formula (I) such as Kester Wax K 82 P (Examples), and Kester Wax 80 P in the instant application. See below for formula I.

[034] Tacky waxes that may be used include the C<sub>20</sub>-C<sub>40</sub> alkyl (hydroxystearoyloxy)stearates (the alkyl group comprising from 20 to 40 carbon atoms). For example, the tacky wax that may be used comprises at least one C<sub>20</sub>-C<sub>40</sub> alkyl 12-(12'-hydroxystearoyloxy)stearate of formula (I):



wherein n is an integer ranging from 18 to 38.

[035] Thus, disclosed herein is a makeup or care composition for keratin materials comprising, in a cosmetically acceptable medium, at least one C<sub>20</sub>-C<sub>40</sub> alkyl (hydroxystearoyloxy)stearate (for instance, a C<sub>20</sub>-C<sub>40</sub> alkyl 12-(12'-hydroxystearoyloxy)stearate), for example as disclosed in formula (I) above.

[036] Such at least one wax is sold under the names "Kester Wax K 82 P" and "Kester Wax K 80 P" by the company Koster Keunen.

Specification at paragraph [0161] tests different waxes. These include bees wax, hydrogenated Jojoba oil, hydrogenated castor oil, orange oil, oxypropylenated (5PO) lanolin wax. These 5 waxes tested do not meet a tack of greater than or equal to 0.7 N.s and a hardness of less than or equal to 3.5 MPa claimed in claim 1.

However tacky wax also includes the following waxes, which are not tested. These are:

1. Bayberry wax
2. Hydrogenated jojoba wax
3. Candelillia wax

4. Carnauba wax
5. Hydrogenated rice bran wax
6. Japan wax
7. Jojoba butter
8. Jojoba oil
9. Lanolin wax
10. Microcrystalline wax
11. Mink wax
12. Montan acid wax
13. Montan wax
14. Ouricurry wax
15. Ozokerite wax
16. Rice bran wax
17. Shellac wax
18. Synthetic wax an
19. Synthetic Beeswax ( no formula)

The specification provides insufficient written description to support the genus encompassed by the claim having a tacky wax of tack of greater than or equal to 0.7 N.s and a hardness of less than or equal to 3.5 MPa.

Vas-Cath Inc. v. Mahurkar, 19 USPQ2d 1111, makes clear that "applicant must convey with reasonable clarity to those skilled in the art that, as of the filing date sought, he or she was in possession of the invention. The invention is, for purposes of the 'written description' inquiry,

whatever is now claimed." (See page 1117.) The specification does not "clearly allow persons of ordinary skill in the art to recognize that [he or she] invented what is claimed." (See Vas-Cath at page 1116.)

The skilled artisan cannot envision which waxes are tacky and would possess the property described in claim 1. Adequate written description requires more than a mere statement that it is part of the invention. See *Fieffs v. Revel*, 25 USPQ2d 1601, 1606 (CAFC 1993) and *Amgen Inc. V. Chugai Pharmaceutical Co. Ltd.*, 18 USPQ2d 1016. In *Fiddes v. Baird*, 30 USPQ2d 1481, 1483, claims directed to mammalian FGF's were found unpatentable due to lack of written description for the broad class. The specification provided only the bovine sequence. Finally, *University of California v. Eli Lilly and Co.*, 43 USPQ2d 1398, 1404, 1405 held that: ...To fulfill the written description requirement, a patent specification must describe an invention and do so in sufficient detail that one skilled in the art can clearly conclude that "the inventor invented the claimed invention." *Lockwood v. American Airlines, Inc.*, 107 F.3d 1565, 1572, 41 USPQ2d 1961, 1966 (1997); *In re Gosteli*, 872 F.2d 1008, 1012, 10 USPQ2d 1614, 1618 (Fed. Cir. 1989) (" [T]he description must clearly allow persons of ordinary skill in the art to recognize that [the inventor] invented what is claimed."). Thus, an applicant complies with the written description requirement "by describing the invention, with all its claimed limitations, not that which makes it obvious," and by using "such descriptive means as words, structures, figures, diagrams, formulas, etc., that set forth the claimed invention." *Lockwood*, 107 F.3d at 1572, 41 USPQ2d at 1966.

Therefore, only the tacky wax having formula I shown to possess the required property described in claim 1 and meet the written description provision of 35 USC § 112, first

paragraph. The specification does not teach any other waxes that are tacky actually possessing a tack of greater than or equal to 0.7 N.s and a hardness of less than or equal to 3.5 MPa, and thus formula I disclosed in the specification is not representative of the genus because the genus is highly variant. Applicant is reminded that *Vas-Cath* makes clear that the written description provision of 35 USC § 112 is severable from its enablement provision (See page 1115).

***Response to Arguments***

Applicant's arguments filed 1/26/09 have been fully considered but they are not persuasive.

Applicants' argue:

*“Applicants respectfully disagree. The comparative testing presented in paragraph [0161] demonstrates that a single embodiment of the claimed invention having a tacky wax falling within the claim scope possesses the best combination of physical properties (i.e., stability, viscosity, and consistency) compared to five compositions, each of which did not possess a tacky wax falling within the claim scope. See Specification as-filed at ¶¶ [0162]-[0163]. The facts that the five comparative waxes fall outside the scope of the claims and that potentially some of the other 19 waxes listed by the Examiner may fall outside the scope of the claims is of no import to the question of whether the specification provides adequate written description support for the claims”.*

In response to the above argument, the comparative testing is limited to one wax under the trade name Kester K 82P . Specification did not test many waxes that are conventionally

used in cosmetic compositions for keratin materials and none of the compositions have waxes other than Koster wax which meets claimed tack and hardness claimed and one species tested for claim 1 composition is not representative of genus.

Applicants' also argue:

*"Rather, the question to be answered for written description support is whether the specification "describe[s] the claimed invention is sufficient detail that one skill in the art can reasonably conclude that the inventor had possession of the claimed invention." M.P.E.P. § 2163(I) (citations omitted). In the present case, paragraphs [0026] to [0036] of the specification provides great detail about the claimed tacky waxes and how one of skill in the art could test whether a certain wax is a tacky wax having the claimed tack and hardness. See Specification as-filed at ¶¶ [0033]-[0035]. The tests provided in the specification, coupled with the comparative testing and examples, clearly establish that one of skill in the art would readily recognize that the inventors were in possession of the claimed invention, including the at least one tacky wax with the claimed tack and hardness, and that one can readily perform the described testing to identify other such tacky waxes".*

In response to the above argument, the teaching at paragraphs [0026] to [0036] is to one wax of formula (I) and the testing in the specification is to one species under formula (I). Thus the specification describes compositions using species of formula (I) meeting the requirement of



tacky wax and paragraphs [0026] to [0036] describe formula (I) describing tacky wax and not any other wax described being tacky.

In conclusion, **only the tacky wax having formula I shown to possess the required property described in claim 1 and meet the written description provision of 35 USC § 112, first paragraph.**

Claim 107 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

What is meant by “care compositions”? Is it care composition for skin or nail or hair . Specification does not describe these care compositions.

#### ***Response to Arguments***

Applicant's arguments filed 1/26/09 have been fully considered but they are not persuasive.

Applicants' argue:

*“Applicants submit that one of skill in the art would readily understand that the care composition, as claimed, can be used, for example, on the skin, the nails, the eyelashes, the eyebrows, and the hair. See Specification as-filed at 11 [0002] (Disclosing that the claimed cosmetic composition may be used, for example, “in the field of makeup or care of human keratin materials such as the skin, the nails, the eyelashes, the eyebrows and the hair. Also disclosed herein is a cosmetic care or makeup process for keratin materials.”). Thus, one of skill in the art would understand*

*from reading the specification the meaning of "care compositions," and, therefore, that term is not indefinite".*

In response to the above argument, specification fails to describe the scope for "care composition". Note that claim 107 is drawn to two embodiments, which can be "care composition" or "make-up composition". "Care composition for skin means the composition is used for taking care of problems associated with skin. This can be treating wrinkles or treating pigmentation or dry skin or oily skin. If it is care composition for nails it means that the compositions are used for treating fungal infections. Care composition for hair means the compositions are used for treating dandruff or treating baldness. Specification fails to describe the scope for "care composition" other than make-up compositions.

Therefore the expression "care composition" lacks clarity.

***Claim Rejections - 35 USC § 103***

Claims 1-24 and 79-107 are rejected under 35 U.S.C. 103(a) as being unpatentable over the combination of 5,985,298 ('298) and U.S. Patents 5,783,176 ('176).

Patent '298 teaches cosmetic compositions. See col.5, ll 41-65 for mascara compositions and these compositions have wax. The compositions have volatile solvent and non-volatile oil, film former and emulsifier (surfactant claimed in claim 101). The waxes include Kester wax, which is also known as synthetic bees wax. Example 2 has bees wax and synthetic wax instead of synthetic bees wax. The example drawn to mascara has water (solvent). Patent also teaches other cosmetic compositions and this has ethyl alcohol (claims 79-84). The weight percent of the solvent is also within the claimed range. Mascara composition has film former, which is polyethylene. Example 2 has 4 types of waxes. Example 2 has carnauba wax and candelilla wax.

The weight percent disclosed in example 2 is within the weight percent claimed. Example 2 has additional wax which is claimed in claims 97-100. The weight percent disclosed in example 2 is within the weight percent claimed. Patent also teaches other cosmetic compositions and this has ethyl alcohol (claims 79-84). The weight percent of the solvent is also within the claimed range. See also col.6, line 50 through col.7, line 32.Examples 1-5 do not have UV screening agent (claim 103). See all the examples drawn to various cosmetic formulations (claims 104-107). The combination of volatile oil and non volatile solvent belongs to claimed fatty phase. See col.2, line 20 through col.4, line 21 for fatty phase. see col.4, ll 48-50, col.5, ll 34-62. The weight percent of volatile solvent and non-volatile oil taught by the patent is within the weight percent claimed for the volatile oil and non-volatile oil ( claims 85-92). See col. 4, ll 22-24 for the various cosmetic products. Patent also teaches film formers at paragraph bridging col.s 5-6 and teaches that various film formers disclosed in CTFA handbook can be used ( claim 93). The difference between the patent and the instant application is patent does not disclose formula I claimed in claims 10-11 for tacky wax. However, patent '176 teaches tacky wax claimed in instant application as ester. See the abstract, see col.3, ll 30 through col.4, line 65 and see the paragraph bridging col.s 4-5. Patent at col.5, ll 35-45 teaches surfactants and at col.5, ll 52-61 teaches solvents and at col.8, ll 39-65 teaches conventional cosmetic additives. See the examples.

Accordingly, it would be obvious to one of ordinary skill in the art at the time the invention was made to prepare compositions of patent '298 and substitute synthetic bees was for bees wax or synthetic wax taught in the mascara compositions. One of ordinary skill in the art would substitute the functional equivalents expecting that the synthetic bees wax can also be used in composition. With respect to claims 10-11, one of ordinary skill in the art would

substitute the synthetic beeswax of patent '298 to ester of patent '176 (claimed in instant application as tacky wax and also known as synthetic wax since INCI name for Kester wax is synthetic bees wax) . One of ordinary skill in the art would substitute the functional equivalents expecting that the ester of patent '176 ( INCI name is synthetic bees wax) can also be used in composition. This is a prima facie case of obviousness.

***Response to Arguments***

Applicant's arguments filed 1/26/09 have been fully considered but they are not persuasive.

Applicants' argue:

*"To begin with, Applicants acknowledge that Brieva broadly discloses mascara compositions having 0.1-30% wax. See Brieva, col. 5, lines 41-53. Applicants further acknowledge that Brieva discloses that "suitable" waxes include*

*natural and synthetic waxes such as bayberry wax, beeswax, candelillia wax, carnauba, ceresin, cetyl esters, hydrogenated jojoba oil, hydrogenated jojoba wax, hydrogenated rice bran wax, japan wax, jojoba butter, jojoba oil, jojoba wax, lanolin wax, microcrystalline, mink, montan acid, montan, ouricury, ozokerite, rice bran, shellac, synthetic beeswax, and synthetic wax, etc. Id. at col. 5, lines 58-65.*

*Brieva, however, says nothing about the tack and hardness of those waxes and also nothing about whether the disclosed mascara compositions contain at least 27% of at least one tacky wax as claimed.*

*The Examiner points to Example 2 of Brieva arguing that the waxes fall within the claimed amount. Applicants respectfully disagree. Example 2 discloses a mascara composition containing, inter alia, carnauba wax (4.25%), candelillia wax (9.25%), beeswax (4.60%), and synthetic wax (4.85%). See id. at col. 7, lines 62-65. These waxes add up 22.95% wax present in the disclosed mascara composition, which is less than the claimed amount of at least 27% of at least one tacky wax”.*

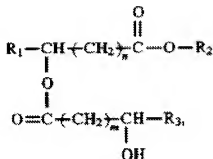
In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

Patent '298 teaches waxes in cosmetic compositions and the weight percent is 0.1-30% wax and the claimed wax of at least 27% is within the weight percent of wax taught by patent '298 and example 2 teaches synthetic wax but not the synthetic bees wax since Kester wax taught by specification as tacky wax has the INCI name synthetic bees wax and patent '176 teaches tacky wax claimed in instant application as ester and one of ordinary skill in the art would prepare compositions of patent '298 and substitute bees wax or synthetic wax taught in the mascara compositions of patent '298 with tacky wax of patent '176 (INCI name synthetic bees wax) expecting predictable results.

Applicants' also argue:

*“Finally, as discussed above, the instant specification provides comparative testing demonstrating that a single mascara composition comprising at least one tacky wax falling within the claim scope (i.e., Example 1) has the best combination of physical properties (e.g., stability, viscosity, and consistency) compared with five mascara compositions containing waxes falling outside the scope of the claims. See Specification as-filed at 1[I] [0184]-[0193]. Such testing establishes unpredictability in the choice of wax, leading to benefits not recognized or predicted by the prior art, including Brieva and Meiring”.*

In response to the above argument, patent '176 teaches ester having the following formula in cosmetic formulations.

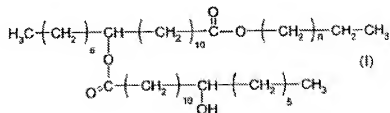


wherein

**R1 and R3 independently of one another are a branched or unbranched saturated hydrocarbon radical having 3-30 carbon atoms and R2 is a branched or unbranched saturated hydrocarbon radical having 5-50 carbon atoms, and n and m independently of one another assume values from 5 to 25.**

The tacky wax of claim 11 has the following formula:

11. The composition according to Claim 10, wherein the at least one C<sub>20</sub>-C<sub>40</sub> alkyl (hydroxystearoyloxy)stearate is chosen from compounds of formula (I):



wherein n is an integer ranging from 18 to 38.

There is overlap regarding variables. In patent R1 can be 3-30 carbon atoms and in instant application R1 corresponds to 5 carbons. In patent n can be 5-25 and in instant

application n is 10. In patent R2 can be 5-50 carbon atoms and in instant application the carbon range can be 20-41 (  $n=18-38$ ). In patent m is 5-25 and in instant application the value is 10. In patent R3 can be 3-30 carbon atoms and in instant application the value is 6. Thus there is overlap with the ranges . **What is the value of n for tacky wax in example 1 of specification?**  
**The showing in the specification is not commensurate with the scope of claims.**

In conclusion the claims are prima facie obvious over the combination of patents '298 and '176 within the meaning of 35 U. S. C. 103.

#### ***Double Patenting***

Claims 1-24 and 79-107 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-31 and 73-100 of copending Application No. 10/654,887. Although the conflicting claims are not identical, they are not patentably distinct from each other because there is overlap of subject matter with respect to compositions claimed in the co-pending application and the instant application. Both the instant application and co-pending application use tacky wax, film forming polymer and other additives in the. There is overlap of subject matter in the instant and co-pending application.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

#### ***Response to Arguments***

Applicant's arguments filed 1/26/09 have been fully considered but they are not persuasive.

Applicants' agree with the double patenting rejection and point out that they will submit terminal disclaimer when the allowable subject matter is indicated.



This application contains claims 25-78 and 108-117 drawn to an invention nonelected with traverse in the reply filed on 1/11/07. A complete reply to the final rejection must include cancellation of nonelected claims or other appropriate action (37 CFR 1.144) See MPEP § 821.01.

***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JYOTHSNA A. VENKAT whose telephone number is 571-272-0607. The examiner can normally be reached on Monday-Friday, 10:30-7:30:1st Friday off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, MICHAEL WOODWARD can be reached on 571-272-8373. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/JYOTHSNA A VENKAT /  
Primary Examiner, Art Unit 1619